## REMARKS

All pending claims 1-3 and 5 are rejected under 35 USC 103(a).

Applicant has amended claim 1. No claim has been canceled. For the reasons discussed below, claims 1-3 and 5 are patentable over the cited prior art. Withdrawal of the rejections is requested.

### Claim Rejections - under 35 U.S.C. 103(a)

Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann (US 6,285,985).

Applicant respectfully traverses the rejection. Nevertheless, Applicant has amended claim 1 to more clearly define the present invention and, for reasons set forth below, the amended claim 1 is patentable over the cited prior art.

The amended claim 1 recites:

> An advertising method using software products in which at least one advertisement is inserted so that the software products can be distributed for free or at a low cost, the advertising method comprising the steps of:
> *inserting at least one advertisement into at least one portion of a software program contained in a software product during the making of the software product;*
> making the software program stop in operation during use of the software program when the inserted advertisement is displayed on a display screen; and
> *resuming the software program only when the inserted advertisement displayed on the display screen is clicked on;*
> *wherein the software program with the inserted advertisement is reproducible and operable without connecting to the Internet.*

Horstmann does not teach or suggest the above emphasized features of the present invention.

The final Office Action asserted that "Horstmann teaches an advertising method using software products comprising: inserting at least one advertisement into at least a portion of a software program (col. 2, lines 1-15, 64-67, col. 1, lines 15-20)". Applicant respectfully disagrees with the Examiner's interpretation of the cited reference. On col. 2, lines 1-15, Horstmann teaches that an advertisement module is attached to the software. "The function of the advertisement module is to retrieve advertisements from an advertisement sever and to display them to the user. The advertisements are varied to retain the interest of the user." On

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col. 2, lines 64-67, Horstmann teaches that "the Ad Module Builder Tool allows a software developer to attach the ad module to a program on-site in a simple, straight-forward manner without source code changes." The above teachings of Horstmann only teach to attach an advertisement module to the software and how. In order to display an advertisement to the user, the advertisement module would have to retrieve the advertisement from an advertisement server. Claim 1 of Horstmann further clarifies that the advertisement sever is a *remote* advertisement sever. Col. 5, lines 36-38.

From above discussion, it is clear that, in Horstmann, the advertisement is not inserted into the software program *during the making of the software product* as required by claim 1.

The Advisory Action stated that "Horstmann does meet the claim limitation since, regardless of the source, advertisement(s) are inserted into at least a portion of the software program". Applicant respectfully disagrees.

In the present invention as defined in claim 1, the advertisement is directly inserted into a software program during the making of the software product, therefore, the software with the inserted advertisement is reproducible and operable without connecting to the Internet. Horstmann does not teach or suggest that the software program of Horstmann can be reproduced together with the advertisement provided through the advertisement sever. And the software product of Horstmann clearly cannot be operated without connecting to the Internet because the advertisement module has to retrieve the desired advertisement from a remote advertisement sever through the Internet. Col. 3, lines 1-5, 57-61; Col. 4, lines 48-61; Col. 5, lines 5-13; Figs. 4 and 5. Attaching an advertisement module to a software program is different from inserting an advertisement

Further, inserting an advertisement into a software program during the making thereof would be against the intended purpose of Horstmann. Horstmann expressly teaches that "[T]he advertisements are varied to retain the interest of the user". Col. 2, lines 9-10. "The function of the ad module is to retrieve and display to the user of the program various advertisements. ... advertisements are retrieved over the Internet (107) from an ad sever 109." Col. 3, lines 1-4. Once an advertisement is inserted into a software program during the making thereof, it will stay with the software in a recording medium, and cannot be varied without repeating the making process, that would be against the above teachings of Horstmann.

Claim 1 further recites steps of "making the software program stop in operation during use of the software program when a sponsored advertisement is displayed on a display screen; and

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resuming the software program only when the sponsored advertisement displayed on the screen is clicked on". Horstmann does not teach or suggest such features either. Indeed, Horstmann does not teach an advertisement inserting concept, rather he only discloses an advertisement module which is attached to a software product to provide advertisements through an advertisement server. In other words, in Horstmann's method, the advertisement window inserted or appearing in the software is not interlocked with the stopping and assuming operation of the software.
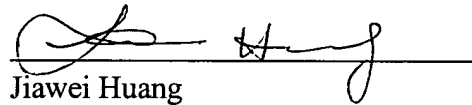
For at least the reasons discussed above, the amended claim 1 is patentable over Horstmann. Claims 2-3 and 5 depend from claim 1 and, thus, are also patentable over Horstmann for at least the same reasons.

## Conclusion

In view of the foregoing remarks, it is respectfully submitted that the remaining claims 1-3 and 5 are fully in condition for allowance and such allowance is earnestly solicited.

Respectively submitted

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## VERSION WITH MARKINGS TO SHOW CHANGES MADE

**In the Claims:**

Claims 1 has been amended as follows:

1.     (Twice Amended) An advertising method using software products in which at least one advertisement is inserted so that the software products can be distributed for free or at a low cost, the advertising method comprising the steps of:

inserting at least one advertisement into at least one portion of a software program contained in a software product[, by support from an advertising sponsor] during the making of the software product;

making the software program stop in operation during use of the software program when [a sponsored] the inserted advertisement is displayed on a display screen; and

resuming the software program only when the [sponsored] inserted advertisement displayed on the display screen is clicked on;

wherein the software program with the inserted advertisement is reproducible and operable without connecting to the Internet.

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